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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/912,561	07/26/2001	Toshiharu Katsuki	Q65527	5480
7590 12/22/2004 SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC 2100 Pennsylvania Avenue Washington, DC 20037-3213			EXAMINER JUSKA, CHERYL ANN	
			ART UNIT 1771	PAPER NUMBER

DATE MAILED: 12/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/912,561

Applicant(s)

KATSUKI ET AL. 

Examiner

Cheryl Juska

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 6, 7, 19, 20, 25 and 26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6, 7, 19 and 20 is/are rejected.
- 7) ☒ Claim(s) 25 and 26 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's amendment filed October 13, 2004, has been entered. Claims 21-24 have been cancelled and new claims 25 and 26 have been added. Thus, the pending claims are 6, 7, 19, 20, 25, and 26.
2. Said amendment renders moot the 112, 2<sup>nd</sup> rejection of claims 21-24 as set forth in section 6 of the last Office Action.

### ***Claim Objections***

3. Claims 25 and 26 are objected to because of the following informalities: The preamble does not reflect the method recited. Specifically, said claims are drawn to a method of *preparing fabric for use* in ink jet printing, yet the steps include printing. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
5. Claims 6 and 19 stand rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,683,784 issued to Nakao et al.
6. Claims 7 and 20 stand rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,683,784 issued to Nakao et al.

***Response to Arguments***

7. Applicant's arguments filed with the amendment have been fully considered but they are not persuasive. Specifically, applicant argues that Nakao does not teach the claimed coating since Nakao's two binders, polyvinyl alcohol and hydrophilic acrylic resin, are both of high wettability (Amendment, page 5, 1<sup>st</sup> paragraph). The examiner respectfully disagrees. While the working examples of Nakao may teach said two particular binders, Nakao also teaches the binder for the boehmite layer may be a natural or semi-synthetic polymer, such as starch, carboxymethyl cellulose, or hydroxymethyl cellulose, rather than polyvinyl alcohol. Thus, the first layer of Nakao may have a synthetic polymer coating, while the second layer may have a natural or semi-synthetic layer. Thus, applicant's argument is found unpersuasive.

8. Applicant also argues that Nakao teaches a reverse order for the two coatings with respect to the printing side (Amendment, page 5, paragraphs 3-5). This argument is also unpersuasive because applicant's claims do not necessarily exclude a reverse embodiment. Specifically, with respect to the order of coatings, claims 6 and 7 merely state that the agent of low wettability is applied to the fabric "from the fabric's nonprinting side." However, this limitation is not given patentable weight at this time since the claims do not positively recite a printing step that would define which side of the fabric is the printing side. In other words, the recitation to a nonprinting side is not relevant to the presently claimed method since said method is not drawn to printing. Therefore, applicant's arguments are found unpersuasive and the above rejections stand.

*Allowable Subject Matter*

9. Claims 25 and 26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The cited prior art does not teach or suggest the presently claimed method of coating an ink holding agent of high wettability to a synthetic fabric, coating an ink holding agent of low wettability onto said fabric from a nonprinting side, ink jet printing, applying heat treatment, and applying a soaping treatment (i.e., washing). Note that the cited Nakao reference applies the natural or semi-synthetic binder for the boehmite coating, which is the printing side of the fabric. Additionally, Nakao does not teach the claimed heat treatment and washing steps.

*Conclusion*

10. The art made of record and not relied upon is considered pertinent to applicant's disclosure.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

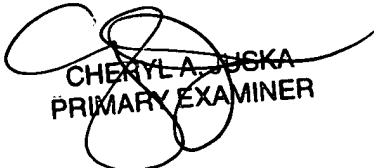
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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Juska whose telephone number is 571-272-1477. The examiner can normally be reached on Monday-Friday 10am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached at 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
CHERYL A. JUSKA  
PRIMARY EXAMINER

cj  
December 16, 2004